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REPLY TO EXAMINER'S ANSWER

Provisional Double Patenting Rejection

The Examiner *provisionally* rejected claims 1-40 under the judiciary created doctrine of obviousness-type double patenting as being unpatentable over claims 1-61 of co-pending Application No. 10/055,649. Appellants traverse this rejection on the grounds that the Examiner has not stated a *prima facie* rejection according to MPEP 804.II.B.1.

In the Examiner's Answer under (I), the Examiner asserts that "the Examiner provides an analysis of claim 1 of the instant application with claim 18 of copending application 10/055,649 to show that claim 18 contains all the limitations of claim 1 of the instant application. In other words, the claim 18 anticipates claim 1 of the instant application." The Examiner then repeats the same previously provided table comparing claim 1 of the instant application and claim 18 of application number 10/055,649. However, there are differences between how claim 1 of the present application is worded compared to claim 18 of application number 10/055,649. Contrary to the Examiner's assertion, simply providing a side-by-side table comparing two claims is not providing an "analysis." Simply providing a side-by-side table comparing two claims is not a valid reason why a person of ordinary skill in the art would conclude that the invention defined in the claim is an obvious variation of the invention defined in a claim of the other patent/application. All the Examiner has actually done is taken elements of claim 1 of the instant application and placed them side-by-side with large portions of claim 18 of 10/055,649. As can be seen from the Examiner's table, there are differences between the claims. The Examiner has not provided any reasons or evidence showing that the differences would be obvious. The Examiner has given **no reason** why a person of ordinary skill in the art would conclude that the invention defined in the claim of the instant application is an obvious variation of the invention defined in a claim of the other patent/application. The Examiner has not stated proper grounds for rejection.

Furthermore, claim 1 is the only claim for which the Examiner has even attempted to establish a *prima facie* rejection. Therefore, the rejection of claims 2-40 is clearly improper. The Examiner has failed to specifically address **each difference of each rejected claim** of the instant application compared to the claims of the other application. Instead, the Examiner improperly lumps all the claims together and does not address each specific difference.

The Examiner clearly has not met the requirements stated in MPEP 804.II.B.1 to establish a *prima facie* obviousness-type double patenting rejection. Accordingly, Appellants respectfully request removal of the double patenting rejection of claims 1-40.

Art Rejections:

35 U.S.C. § 103(a) Rejection

Appellants have argued that the rejection of claim 1 is improper because the Examiner has not shown that Teodosiu qualifies as a prior art reference. More specifically, Teodosiu is a published U.S. patent application that was filed on Sep. 13, 2001, after Appellants' priority date of Jan. 22, 2001. Teodosiu does claim the benefit of two provisional applications both filed Nov. 22, 2000. However, the Nov. 22, 2000 filing date can only be used as Teodosiu's 35 U.S.C. § 103(a) prior art date for the subject matter that is common to both the published application and the provisional application.

In the Examiner's Answer under (II), the Examiner asserts that "both of Teodosiu's Pub. No. 2002/0062375 and provisional application 60/252,658 provide the same description of locator and tracking service for peer-to-peer resources using Resource Naming Service (RNS). Teodosiu's provisional application 60/252,658 teaches the portions that Examiner relied upon in Teodosiu's Pub. No. 2002/0062375 to reject applicant's claimed invention." Appellants note that the Examiner's response

simply restates the Examiner's assertion from the Final Office Action of January 30, 2007.

Contrary to the Examiner's assertion, review of the portions copied by the Examiner shows that much of the teachings used by the Examiner in the rejection are clearly not present in either provisional application.

Specifically, the Examiner has not shown that every portion of Teodosiu relied upon by the Examiner to reject Appellants' claims is found in one of Teodosiu's provisional applications. For example, in the rejection of claims 1-6, 8-18, 21 and 23-40, the Examiner relies on the following paragraphs of Teodosiu: [0016], [0030 - 0037], [0045], [0053], [0073], [0074], [0077], [0094 - 0097]. **None of these paragraphs are found in either of Teodosiu's provisional applications.** These paragraphs from Teodosiu's published application are **not found** in the portion of Teodosiu's provisional application number 60/252,685 copied by the Examiner in the Final Office Action dated January 30, 2007. The Nov. 22, 2000 filing date can only be used as Teodosiu's 35 U.S.C. § 103(a) prior art date for the subject matter that is **common** to both the published application and the provisional application. *See, In re Wertheim*, 209 USPQ 554 (CCPA 1981). **Since portions of Teodosiu relied upon by the Examiner to reject the claims are not common to both Teodosiu's published application and one of Teodosiu's provisional applications, the rejection is improper.**

Additionally, Teodosiu's published application is not entitled to the Nov. 22, 2000 date as a section 103(a) prior art date unless at least one claim of Teodosiu's published application is supported (under 35 U.S.C. § 112) in the provisional application. Under 35 U.S.C. 119(e)(1), a published utility application is not entitled to its provisional application's filing date as a prior art date unless at least one claim of the published utility application is supported (per 35 U.S.C. § 112) in the provisional application. Since both of Teodosiu's provisional applications are much shorter informal papers as compared to Teodosiu's utility application, it is not at all clear that either one of Teodosiu's provisional applications provide full 35 U.S.C. § 112 support for any of the

claims of Teodosiu's published utility application. The rejection is improper unless the Examiner can show that Teodosiu's published application has the necessary claim support in the provisional application to be entitled to the provisional application's filing date as its § 103(a) prior art date. **Since Teodosiu's provisional applications do not satisfy the written description and enablement requirements for any claim of Teodosiu's published application, the provisional applications cannot be used for Teodosiu's prior art date.** See, M.P.E.P. § 2136.03(IV).

The Examiner has the burden of proof to produce the factual basis for the rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). **Since the Examiner has not proven that both of the above requirements have been met for Teodosiu's teachings to qualify as prior art, the Examiner has not met this burden of proof and the rejection is improper.**

Appellants also refer to the Decision on Appeal (Appeal 2007-2225, Application 10/054,809, Technology Center 2100, Decided August 31, 2007). In that case, the same Teodosiu reference was used in rejecting Patent Application 10/054,809, which has the same filing date and priority date as the instant application (January 22, 2002 and Jan. 22, 2001, respectively). From the Decision (emphasis added):

The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). The one who bears the initial burden of presenting a prima facie case of unpatentability is the examiner. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)

...In accordance with the Examiner's theory that some or all of the Teodosiu published application may be applied against the instant claims, the rejection should show, to establish a prima facie case for unpatentability, where § 112 support resides in the earlier provisional applications for each instance of specific subject matter relied upon in the published applications, including an explanation why the provisionals would still be recognized by the artisan as providing support if not "word for word" the same as the later text or drawings. Mere reference to the text or drawings of Teodosiu is not sufficient. The Teodosiu published application, by itself, shows no more than the

material published from the application that was filed in the USPTO on September 13, 2001, which, according to this record, is later than the effective filing date of each of the claims rejected. (emphasis added)

For at least the same reasons stated by the Board in the Decision on Appeal in Application 10/054,809, Appellants assert that Teodosiu has not been established to be prior art to the present application.

Claims 1, 2, 10, and 18:

In regard to claim 1, Appellants have argued that the rejection of claim 1 is improper because the art relied upon by the Examiner fails to teach or suggest a *peer computing system comprising: a plurality of peer nodes; wherein at least a subset of the peer nodes are configured to participate in a peer discovery protocol to discover other peer nodes.*

In the Examiner's Answer under (III), the Examiner simply repeats the citations previously presented from Teodosiu and asserts "any peer can register to participate in peer-to-peer realm, and registered peers are assigned unique identifiers. Peer can access to discover peer resources within the realm by communicating with peer's home RNS server." Teodosiu clearly describes a "two-step process" for accessing a resource that does not involve the initiating peer participating with any other peer node; instead, the process relies on a central RNS server. Teodosiu describes an **RNS server** with which peers must communicate to request locations of resources as a first step in the process. If the RNS server determines one or more locations within a "realm" where the resource is expected to be available, the RNS server returns the locations to the requesting peer. The second step of the process is the peer actually accessing the resource at the provided location(s). Teodosiu states that it is "up to the peer" to take this second step. Thus, Teodosiu clearly does **not** describe in the provided citations (or elsewhere) peers participating with other peers in a peer discovery protocol to discover other peer nodes. Teodosiu's teachings of a locator service that depends on a central RNS server is fundamentally different than the notion of *peer nodes that are configured to participate*

(with other peer nodes) in a peer discovery protocol to discover other peer nodes, as is recited in claim 1. Furthermore, Appellants can find no teaching or suggestion in Teodosiu that the “resources” that may be located using the RNS server include peer nodes.

Furthermore, portions of Teodosiu cited by the Examiner are not found in either of Teodosiu’s provisional applications, and thus cannot be relied upon as prior art to reject Appellants’ claim.

In further regard to claim 1, Appellants have argued that the rejection of claim 1 is improper because the art relied upon by the Examiner fails to teach or suggest at least a subset of the peer nodes are configured to participate in a peer membership protocol for joining or forming a peer group with other peer nodes.

In the Examiner’s Answer under (IV), the Examiner simply re-asserts the Examiner’s previous assertion from the Final Office Action of January 30, 2007. The Examiner did not substantively respond to the Appellants’ arguments in regard to this limitation from claim 1 presented in the Appeal Brief.

Claims 3 and 4:

In regard to claim 3, Appellants have argued that the rejection of claim 3 is improper because the art relied upon by the Examiner fails to teach or suggest *wherein said peer group is a collection of cooperating peer nodes that provide a common set of services in the peer computing system.*

In the Examiner's Answer under (V), the Examiner asserts "Teodosiu teach[es] multiple peers provide peer copies for the same resources in the realm (page 2, paragraph [0016]." The Examiner has simply re-asserted the Examiner's previous assertion from the Final Office Action of January 30, 2007. The Examiner did not substantively respond to the Appellants' arguments in regard to claim 3 presented in the Appeal Brief.

Furthermore, the portion of Teodosiu cited by the Examiner is not found in either of Teodosiu's provisional applications, and thus cannot be relied upon as prior art to reject Appellants' claim.

Claim 5

Appellants note that, in the Examiner's Answer under (VI), the Examiner withdrew the rejection of this claim.

Claims 6 and 21

In regard to claim 6, Appellants have argued that the rejection of claim 6 is improper because the art relied upon by the Examiner fails to teach or suggest a *peer computing system wherein one or more peer nodes in said peer group are configured to participate in a peer resolver protocol configured for use in sending search queries from one peer group member to another peer group member.*

In the Examiner's Answer under (VII), the Examiner simply re-asserts the Examiner's previous assertion from the Final Office Action of January 30, 2007. The Examiner did not substantively respond to the Appellants' arguments in regard to claim 6 presented in the Appeal Brief.

Furthermore, the portion of Teodosiu cited by the Examiner is not found in either of Teodosiu's provisional applications, and thus cannot be relied upon as prior art to reject Appellants' claim.

Claims 8 and 23

In regard to claim 8, Appellants have argued that the rejection of claim 8 is improper because the art relied upon by the Examiner fails to teach or suggest a peer computing system, wherein one or more peer nodes in said peer group are configured to participate in an endpoint routing protocol for enabling the peer nodes to request peer routing information to reach other peer nodes.

In the Examiner's Answer under (VIII), the Examiner simply re-asserts the Examiner's previous assertion from the Final Office Action of January 30, 2007. The Examiner did not substantively respond to the Appellants' arguments in regard to claim 8 presented in the Appeal Brief.

Furthermore, the portion of Teodosiu cited by the Examiner is not found in either of Teodosiu's provisional applications, and thus cannot be relied upon as prior art to reject Appellants' claim.

Claims 9 and 24

In regard to claim 9, Appellants have argued that the rejection of claim 9 is improper because the art relied upon by the Examiner fails to teach or suggest a peer computing system, wherein at least a subset of the peer nodes are configured to participate in a peer information protocol for enabling the peer nodes to learn about other peer nodes' capabilities and status.

In the Examiner's Answer under (IX), the Examiner simply re-asserts the Examiner's previous assertion from the Final Office Action of January 30, 2007. The

Examiner did not substantively respond to the Appellants' arguments in regard to claim 9 presented in the Appeal Brief.

Furthermore, the portions of Teodosiu cited by the Examiner are not found in either of Teodosiu's provisional applications, and thus cannot be relied upon as prior art to reject Appellants' claim.

Claim 11

In regard to claim 11, Appellants have argued that the rejection of claim 11 is improper because the art relied upon by the Examiner fails to teach or suggest *wherein the resources include one or more of the peer nodes, peer groups, content, services, applications, pipes, and pipe endpoints, wherein the pipes are communications channels between one or more of the peer nodes, the services, and the applications in the peer-to-peer environment, and wherein the pipe endpoints are network interfaces on the peer nodes that are configured to be bound to the pipes to establish the communications channels.*

In the Examiner's Answer under (X), the Examiner asserts "Teodosiu teaches resources in peer-to-peer realm include peers, servers, content, services, applications, communication channels between any elements in the peer-to-peer realm." **Appellants can find nothing in Teodosiu, neither in the cited portions nor elsewhere, that teaches what the Examiner asserts. Nowhere does Teodosiu teach that the "resources" referred to throughout the Teodosiu application include "peers, servers, content, services, applications, communication channels between any elements in the peer-to-peer realm."**

Furthermore, the resources mentioned in claim 11 refer to the resources for which advertisements may be published in the peer-to-peer environment in accordance with the advertisement format. Appellants can find nothing in the cited sections of Teodosiu that

teaches or suggests the notion of publishing advertisements for *one or more of peer nodes, peer groups, content, services, applications, pipes, and pipe endpoints*.

Furthermore, Appellants can find nothing in the cited art that teaches or suggests the notion of *pipes* that are defined as *communications channels between one or more of the peer nodes, the services, and the applications in the peer-to-peer environment*, or the notion that *pipe endpoints* are *network interfaces on the peer nodes that are configured to be bound to the pipes to establish the communications channels*. FIG. 3 of Teodosiu, cited by the Examiner, simply illustrates the notion of various “traffic” coming in and out of a peer, and does not teach or suggest the notion of pipes and pipe endpoints as recited in claim 11. Teodosiu clearly does not teach or suggest the notion of advertisements for pipes and pipe endpoints as recited in claim 11.

Furthermore, portions of Teodosiu cited by the Examiner are not found in Teodosiu’s provisional applications and thus cannot be used to reject Appellants’ claims.

Claim 37

Appellants note that, in the Examiner’s Answer under (XI), the Examiner withdrew the rejection of this claim.

Claim 12-17, 25-36, 38, and 40

In the Examiner’s Answer under (XII), in reference to these claims, the Examiner refers to the discussion applied for rejecting claims 1-6, 8-9, and 11. Appellants refer to the responses given above in regards to these claims.

CONCLUSION

For the foregoing reasons submitted in the Appeal Brief and this Reply Brief, it is submitted that the Examiner's rejections of the claims is erroneous, and reversal of his decision is respectfully requested.

The Commissioner is authorized to charge any fees that may be due to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5181-82104/RCK. This Reply Brief is submitted with a return receipt postcard.

Respectfully submitted,

/Robert C. Kowert/

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Date: November 24, 2008